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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,518	09/17/2003	Theodore B. Shockley	35481-73372	4878

23643 7590 04/22/2005

BARNES & THORNBURG
11 SOUTH MERIDIAN
INDIANAPOLIS, IN 46204

EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,518

Applicant(s)

SHOCKLEY, THEODORE B.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Submission of Prior Art (ASPA) in view of Friesch ('453) and further in view of Takeda et al. ('821).

ASPA discloses a plurality of tickets comprising a sheet of stock paper having perforations defining detachable tickets therebetween (as seen Fig. 1; Prior Art).

ASPA discloses the claimed invention except for the substrate having a caliper characteristic between 5 and 8 points.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

ASPA, as modified by Friesch, discloses the claimed invention except for the claimed opacity characteristic of less than 98%.

Takeda et al. disclose synthetic paper substrates having an opacity value of 97% (which is less than 98%). Therefore, it would have been obvious to one having ordinary

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skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Regarding claims 2 and 16, ASPA, as modified by Friesch and Takeda et al., discloses the claimed invention except for the claimed number of tickets on the roll being 1000 or 2000. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required number of tickets on the roll, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding claims 3, 15 and 17, ASPA, as modified by Friesch and Takeda et al., discloses the claimed invention except for the diameter of the roll being less than 4.5 inches or 6.5 inches. It would have been an obvious matter of design choice to provide any required dimension for the diameter of the roll, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding the stock paper being reply card stock paper (claims 4 and 13), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the stock paper disclosed in Fig. 1, Prior Art is capable of performing the intended use of being reply card stock paper.

Regarding claims 5, 10, 11, 12 and 18, see the above rejections to claim 1.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over ASPA in view of Friesch.

ASPA discloses a plurality of tickets comprising a sheet of stock paper having perforations defining detachable tickets therebetween (as seen Fig. 1, Prior Art).

ASPA discloses the claimed invention except for the substrate having a caliper characteristic between 5 and 8 points.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

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4. Claims 1-5, 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin, Jr. ('201) in view of Friesch and further in view of Takeda et al.

Austin, Jr. discloses a tube (26) and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see col. 1, lines 67-68 through col. 2 lines 1-2).

Austin, Jr. discloses the claimed invention except for the range of the caliper characteristic being between 5 and 8.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by Austin, Jr. with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

Austin, Jr., as modified by Friesch, discloses the claimed invention except for the claimed opacity characteristic of less than 98%.

Takeda et al. disclose synthetic paper substrates having an opacity value of 97% (which is less than 98%). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by Austin, Jr. with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Regarding claims 2 and 16, Austin, Jr., as modified by Friesch and Takeda et al., discloses the claimed invention except for the claimed number of tickets on the roll

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being 1000 or 2000. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required number of tickets on the roll, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding claims 3, 15 and 17, Austin, Jr., as modified by Friesch and Takeda et al., discloses the claimed invention except for the diameter of the roll being less than 4.5 inches or 6.5 inches. It would have been an obvious matter of design choice to provide any required dimension for the diameter of the roll, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, applicant has failed to disclose that these values are critical to the invention.

Regarding the stock paper being reply card stock paper (claims 4 and 13), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458,

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459 (CCPA 1963). In this case, the stock paper disclosed in Fig. 1, Prior Art is capable of performing the intended use of being reply card stock paper.

Regarding claims 5, 10, 11, 12 and 18, see the above rejections to claim 1.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Austin, Jr. in view of Friesch.

Austin, Jr. discloses a tube (26) and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween (see col. 1, lines 67-68 through col. 2 lines 1-2).

Austin, Jr. discloses the claimed invention except for the range of the caliper characteristic being between 5 and 8.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by Austin, Jr. with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

6. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over London in view of Takeda et al.

London discloses a plurality of tickets comprising a strip of stock paper having perforations defining detachable tickets therebetween, the strip being folded along at least some of the perforations to form a deck of tickets (as seen in figure 1).

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Regarding the stock paper being reply card stock paper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the stock paper disclosed in London is capable of performing the intended use of being reply card stock paper.

London discloses the claimed invention except for the claimed opacity characteristic of less than 98%.

Takeda et al. disclose synthetic paper substrates having an opacity value of 97% (which is less than 98%). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by London with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Regarding claim 23, London discloses each ticket being marked with a serial number (see col. 1, lines 8-12).

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over London in view of Takeda et al. and further in view of Friesch.

London, as modified by Takeda et al., discloses the claimed invention except for the caliper characteristic being in the range of 5 to 8 points.

Friesch discloses that it is known to provide substrates with a caliper of 7 or less (which is between 5 and 8). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by London with a caliper of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space and is economically manufactured.

Response to Arguments

8. Applicant's arguments filed April 04, 2005 have been fully considered but they are not persuasive.

The rejection based on ASPA, Friesch and Takeda et al.

Applicant argues that neither ASPA nor Friesch teach or suggest providing the ASPA tickets from a substrate having a caliper characteristic between 5 and 8 points. Applicant states that ASPA teaches a caliper characteristic of approximately 9.5, not less and Friesch discloses a container having a twin substrate having a caliper characteristic of 7 or less.

The examiner maintains that ASPA discloses a substrate having a caliper characteristic of *approximately* 9.5. Since the value of the caliper characteristic is *approximately* 9.5, the value is capable of being less than 9.5. Therefore, ASPA

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indicates that it is possible to provide the ticket substrate with a caliper characteristic that is *less than* 9.5. Friesch discloses a container having a twin substrate composition. Friesch discloses that it is known to provide substrates with a caliper characteristic of 7 or less (which would be between the claimed value of 5 and 8). Therefore, it would have been obvious to provide the substrate of ASPA with a caliper characteristic of 7, as taught by Friesch, to provide the substrate with a dimension that reduces storage space.

Applicant further argues that this disclosure is not a teaching or suggestion to use paper having a caliper of 7 to provide a ticket.

A ticket is defined as being:

Abbr. tkt. A paper slip or card indicating that its holder has paid for or is entitled to a specified service, right, or consideration: *a theater ticket; an airline ticket.*¹

The indicia supported on the substrate indicates the specified service of the holder of the ticket. The ticket itself is formed from a substrate in the same manner as the container of Friesch is formed from a substrate. The fact that applicant has claimed his substrate to be a ticket instead of a container does not distinguish it from the prior art references.

The examiner continues to maintain that ASPA, as modified by Friesch, discloses the claimed caliper characteristic of between 5 and 8 of the ticket.

¹*The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

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Applicant argues that there is nothing in Takeda et al. that would have taught or suggested using paper with an opacity of less than 98% in a ticket having a caliper of between 5 and 8.

The examiner continues to maintain that Takeda et al. disclose synthetic paper substrates having an opacity value of less than 98% (97%). Therefore, by providing the substrate of ASPA, as modified by Friesch, with an opacity value of less than 98%, the appearance of the substrate would be advantageously obscured from sight.

Applicant argues that one of ordinary skill would have understood that to optimally obscure the appearance of the substrate, other factors must be considered. The examiner asserts that such a discovery of an optimum value of a result effective variable would involve routine skill in the art. Takeda et al. disclose that the degree of opacity is obtained through various testing procedures to obtain a desired outcome. The examiner, therefore, maintains that it would have been obvious to provide the substrate of ASPA, as modified by Friesch, with an optimal opacity value for obscuring certain indicia printed on the substrate.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The rejection based on Austin, Jr., Friesch and Takeda et al.

Applicant argues that this rejection is improper and maintains the same line of reasoning with Austin, Jr. replacing ASPA.

The examiner, therefore, maintains the same line of reasoning for maintaining the rejections of the claims as set forth above with Austin, Jr. replacing ASPA.

The rejection based on London, Takeda et al. and Friesch

Applicant argues that the combination of London and Takeda et al. would not have been obvious to one having ordinary skill in the art.

The examiner disagrees. London discloses a plurality of tickets having perforations defining detachable tickets therebetween and being folded along some of the perforations to form a deck of tickets. London, however, does not disclose the claimed ticket opacity.

The examiner continues to maintain that Takeda et al. disclose synthetic paper substrates having an opacity value of less than 98% (97%). Therefore, by providing the substrate of London with an opacity value of less than 98%, the appearance of the substrate would be advantageously obscured from sight.

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Applicant argues that one of ordinary skill would have understood that to optimally obscure the appearance of the substrate, other factors must be considered. The examiner asserts that such a discovery of an optimum value of a result effective variable would involve routine skill in the art. Takeda et al. disclose that the degree of opacity is obtained through various testing procedures to obtain a desired outcome. The examiner, therefore, maintains that it would have been obvious to provide the substrate of London with an optimal opacity value for obscuring certain indicia printed on the substrate.

Regarding claim 23, Applicant argues that none of the cited prior art discloses each ticket having a marking imprinted thereon for triggering a light and sensor ticket-counting device.

The examiner disagrees. London discloses each ticket being marked with a serial number (as seen in column 1, lines 8-12).

Regarding the functional limitation of the marking triggering a light and sensor ticket-counting device, while features of an apparatus may be recited either structurally or functionally, claimed directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. (See MPEP 2114). The examiner asserts that the disclosed structure of London is inherently capable of performing the recited function, since each ticket comprises printed indicia that could be sensed by a ticket-counting device.

Regarding claim 22, Applicant argues that this rejection is improper and maintains the same line of reasoning with London replacing ASPA.

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The examiner, therefore, maintains the same line of reasoning for maintaining the rejections of the claim as set forth above with London replacing ASPA.

For the reasons as set forth above, the rejections are maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 19, 2005


MONICA S. CARTER
PRIMARY EXAMINER